

**REMARKS**

This amendment is in response to the Office Action of August 12, 2005.

Claims 1 through 20 are currently pending in the application.

Claims 1 through 20 have been amended herein. Support for the amendments may be found in paragraphs [0006] to [0009], [0027], [0029], [0032], [0033], [0036], and [0038]. No new matter has been entered to the disclosure as the amendment clearly complies with 35 U.S.C. § 132. The amendments are to clarify the invention. The amendments are made without prejudice or disclaimer.

**35 U.S.C. § 102(e) Anticipation Rejections**

Anticipation Rejection Based on Takaira et al. (U.S. Patent 6,750,982)

Claims 1 through 10 and 16 through 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Takaira et al. (U.S. Patent 6,750,982) ("Takaira"). Applicant respectfully traverses this rejection.

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Presently amended independent claim 1 recites a method of distributing data from an e-mail enabled printer, the method comprising . . . retrieving an at least one print job data file from a memory of the e-mail enabled printer; attaching the at least one print job data file to an e-mail; sending the e-mail and attached at least one print job data file to an e-mail enabled device; and storing at least the attached at least one print job data file in a job retention memory of the e-mail enabled device.

Applicant asserts that Takaira does not identically describe, either expressly or inherently, each and every element of claim 1 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Takaira does not describe the element of the claimed invention calling for "attaching said at least one print job data file to

an e-mail." Takaira describes an approach for reducing the labor involved in installing a print driver on a printer user's computer. *Column 1, lines 44 to 57.* Takaira describes –

In delivering electronic mail, the printer drivers are attached to the data for using the printer stored in the user data storing unit 14. Consequently, electronic mail in which the method of setting the printer and the location at which the printer is placed are described is delivered to the individual PCs 4A, 4 B, and 4C with the software for the printer driver for the printer being attached thereto. The delivery of electronic mail is performed via the electronic mail receiving unit 20 and the network I/F unit 6 (S3) [of the printer].

*Column 4, lines 18 to 26.*

The only data that Takaira describes attaching to an e-mail is the software for a printer driver. The only information Takaira describes e-mailing, other than the printer driver, is data for using the printer, such as information on a method of setting the printer and the location of the printer. *See also, Column 2, line 66 to Column 3, line 4.* Applicant asserts that the software for a printer driver is not a print job data file as well as information on a method of setting the printer and the location of the printer is not either. Applicant asserts that there is no express or inherent description in Takaira of attaching a print job data file to an e-mail. Therefore, for at least this reason, presently amended independent claim 1 is not anticipated. Therefore, presently amended independent claim 1 is allowable.

Claims 2 through 10 are allowable for at least the reason of depending from allowable independent claim 1.

Presently amended claim 16 recites a system for distributing data, comprising . . . a network; and at least one e-mail enabled printer for communicating over the network, the e-mail enabled printer comprising at least one microprocessor for operating the e-mail enabled printer; a display panel for displaying print jobs and related data, and a job retention memory for storing the print jobs and the related data for distribution.

Applicant asserts that Takaira does not identically describe, either expressly or inherently, each and every element of claim 16 to anticipate the claimed invention under 35 U.S.C. § 102. Applicant asserts that Takaira does not describe the element of the claimed invention calling for "a job retention memory for storing said print jobs and said related data for distribution."

Applicant asserts that Takaira describes an approach for reducing the labor involved in installing a print driver on a printer user's computer. *Column 1, lines 44 to 57.* Takaira describes –

In delivering electronic mail, the printer drivers are attached to the data for using the printer stored in the user data storing unit 14. Consequently, electronic mail in which the method of setting the printer and the location at which the printer is placed are described is delivered to the individual PCs 4A, 4 B, and 4C with the software for the printer driver for the printer being attached thereto. The delivery of electronic mail is performed via the electronic mail receiving unit 20 and the network I/F unit 6 (S3) [of the printer].

*Column 4, lines 18 to 26.*

Applicant asserts that the only data that Takaira describes distributing is the software for a printer driver and the data for using the printer, such as information on a method of setting the printer and the location at which the printer is placed. *See also, Column 2, line 66 to Column 3, line 4.* Applicant asserts that the software for a printer driver is not a print job or related data as well as the information on a method of setting the printer and the location of the printer is not either. Applicant asserts that there is no express or inherent description in Takaira of distributing "said print jobs and said related data." Therefore, for at least this reason, presently amended claim 16 is not anticipated. Therefore, presently amended independent claim 16 is allowable.

Claims 17 through 20 are allowable for at least the reason of depending from allowable independent claim 16.

### **35 U.S.C. § 103(a) Obviousness Rejections**

#### Obviousness Rejection Based on Takaira in view of Kageyama et al. (U.S. Patent 6,567,180)

Claims 11 through 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Takaira in view of Kageyama et al. (U.S. Patent 6,567,180) ("Kageyama"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant asserts that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of

the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Presently amended independent claim 11 recites a method of distributing a print job, comprising . . . storing one or more print jobs in a memory of an e-mail enabled printer; selecting at least one of the one or more print jobs stored in the memory of the e-mail enabled printer for distribution; creating an e-mail; attaching the selected at least one print job to the e-mail; and sending the e-mail for distributing the selected at least one print jobs.

Applicant asserts that Takaira and Kageyama, even if combined, do not teach all of the claim limitations of presently amended claim 11 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that neither Takaira nor Kageyama, nor any combination thereof, teach or suggest the claim limitation calling for "attaching said selected at least one print job to said e-mail." Applicant asserts that Takaira teaches or suggests an approach for reducing the labor involved in installing a print driver on a printer user's computer. *Column 1, lines 44 to 57.* Takaira teaches or suggests –

In delivering electronic mail, the printer drivers are attached to the data for using the printer stored in the user data storing unit 14. Consequently, electronic mail in which the method of setting the printer and the location at which the printer is placed are described is delivered to the individual PCs 4A, 4 B, and 4C with the software for the printer driver for the printer being attached thereto. The delivery of electronic mail is performed via the electronic mail receiving unit 20 and the network I/F unit 6 (S3) [of the printer].

*Column 4, lines 18 to 26.*

Applicant asserts that the only data that Takaira teaches attaching to an e-mail is the software for a printer driver. The only information Takaira teaches e-mailing, other than the printer driver, is data for using the printer, such as information on a method of setting the printer and the location of the printer. *See also, Column 2, line 66 to Column 3, line 4.* The software for a printer driver is not a print job as well as the information on a method of setting the printer and the location of the printer is not either. Applicant asserts that there is no teaching or suggestion in Takaira of attaching a print job to an e-mail. Applicant asserts that Kageyama does not cure Takaira failings regarding presently amended independent claim 11. Therefore, for at least this

reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established. Therefore, presently amended independent claim 11 is allowable.

Claims 12 through 15 are allowable for at least the reason of depending from allowable presently amended independent claim 11.

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicant has amended the claimed invention to clearly distinguish over the cited prior art.

Applicant submits that claims 1 through 20 are clearly allowable over the cited prior art. Applicant requests the allowance of claims 1 through 20 and the case passed for issue.

Respectfully submitted,



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